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09/524,990	03/14/2000	Rafael Victor Andino	CL/V-30886/A/CGV2116	8536

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT PAPER NUMBER

1722

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/524,990

Applicant(s)

ANDINO ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 26-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-17 and 19-25 is/are rejected.
- 7) ☒ Claim(s) 4 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on June 20, 2003 has been entered.

2. Claims 26-35 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method and apparatus, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 6. .

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-3, 12-15, 17 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kretzschmar et al. (U.S. Pat. No. 5,782,460; previously of record).

Kretzschmar discloses an ophthalmic lens mold. The mold comprises a first mold half (11) having a front side and a back side, the front side defining an optical surface (13). The mold further comprises a second mold half (12) having a front side defining an optical surface (14). The first mold half is aligned with the second mold half so as to oppose each other, and thereby form a mold cavity (15) between the front sides with the optical surfaces (Figure 1A). A ophthalmic lens (CL) is formed in the mold cavity from a moldable material.

The first mold half includes a first section that transmits curing light from a light source (2a) and that from the back side to the front side. The first section includes at least an area of the first mold half optical surface enclosed by the outermost circumference of the ophthalmic lens (see Figures 1A-1C). A second section (21) is provided that blocks the curing light (column 11, lines 7-10). The second section is disposed respect to the first section such that the second section prevents the UV curing light from passing through the first mold half into an area of the cavity (16 and 17) that extends from the front sides of the mold halves and surrounds and extends

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radially outward of a boundary including the circumference (see Figures 1A-1C). The first section passes curing light into an area of the mold cavity bounded by an within the boundary (column 9, lines 51-55).

Kretzschmar discloses the first section to be made from a thermoplastic material (column 9, lines 51-55). Kretzschmar notes that the second section can be coated with a protective layer (column 11, lines 24-26) which would inherently be a thermoplastic material.

Claim 1 recites that the section is "co-molded" with the first section. The only reference to the term "co-molded" in the disclosure of the instant application occurs at p. 3, lines 17-18, which merely recites that the "second section is co-molded with the first mold section and blocks the light." Thus, the specification of the instant application does not provide any special definition of the term "co-molded," and term must be given in broadest reasonable meaning as would be understood by one of ordinary skill in the art. In re Morris, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

In determining the ordinary and customary means that would be attributed to a term by those skilled in the art, dictionary definitions can be used in the process. Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1346,

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65 USPQ2d 1961, 1965 (Fed. Cir. 2003). Webster's dictionary defines the verb mold as "to fit the contours of."¹ Thus, one of ordinary skill in the art could reasonably construe the term "co-molded" as used in the claims of the instant application to mean that the first and second sections fit the contours of one other. Such a definition would further be consistent with the drawings of the instant application which show the first and second sections fitted to the contours of one another (see for example, figure 6).

The apparatus of Kretzschmar anticipates this definition of "co-molded." As shown in figure 1A, the second section (21) co-molds, or fits the contours, of the first mold section (11).

Claims 13-14 and 23-24 recite an intended use of the apparatus. Specifically, the use of ultraviolet and collimated light as the curing light. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963). In the instant case,

¹ Merriam-Webster's Collegiate Dictionary, 10th Edition (Merriam-Webster, Inc. 1998), p.749. See the copy of this page attached to this action.

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Kretzschmer notes that the apparatus can be used with ultraviolet light (column 9, lines 51-55), and the apparatus is structured as to be capable of being used with collimated light. Accordingly Kretzschmer anticipates these limitations.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a),

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the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 5-6, 9-11, 16, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzschmar in view of Doke et al. (U.S. Pat. No. 6,071,111; previously of record).

Kretzschmar discloses the apparatus as described above. Kretzschmar does not disclose the first optical surface to be convex on the first surface, with a convex surface on the back side on the first section, such as to define a central section between the convex surface and the concave surface having a substantially uniform thickness. Kretzschmar also does not disclose the first and second mold halves to include a plurality of protrusions extending forward from the front side of the first mold half.

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Doke discloses a lens molding apparatus wherein a first mold half (4) comprises a front convex optical forming surface. A back concave surface is formed on the back side of the first mold half such that a uniform thickness (12) formed between the front side and back side (see figure 1). Doke notes that such a shape for the first mold half allows for deformation so that an increase for decrease in monomer volume can be accommodated for (column 10, lines 42-48). Doke further discloses the apparatus having protrusions and an annular collar (18 and 20) on the two mold halves to align the two halves and form the molding cavity (column 8, lines 61-63).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of Kretzschmar as such to have made the first optical surface to be convex and the back side surface of the first section to be concave such as to form a uniform thickness between the two surfaces because this would allow for accommodation of increases or decreases in monomer volume as suggested by Doke.

It further would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of Kretzschmar to have used protrusions and an annular collar on the mold halves because this would aid in the

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alignment aid in the alignment of the mold halves in forming the molding cavity as suggested by Doke.

Regarding the use of a plurality of protrusions, as noted above Doke teaches the use of a protrusion structure. Therefore the use of multiple protrusions would be an obvious modification to one of ordinary skill in the art because this would further aid in the alignment of the mold halves. Normally the duplication of known parts for multiplied effect is of no patentable significance unless it can be shown that there is a new and unexpected result. See In re Harza, 274 F.2d 669, 124 USPQ 378 (Cust. & Pat. App. 1960); St. Regis Paper Co. v. Bemis Co., Inc., 549 F.2d 833, 193 USPQ 8 (7th Cir. 1977)

9. Claims 7-8, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzschmar modified by Doke as applied to claims 1-3, 5-6, 9-17 and 20-24 above, and further in view of Friske (U.S. Pat. No. 5,254,000; previously of record).

Kretzschmar and Doke disclose the apparatus as described above. Kretzschmar and Doke do not disclose the first section of the first mold half to include at least one tab extending radially outward from the center section to the second section.

Friske teach a lens molding apparatus wherein the first mold half uses tabs (32) extending from the center section.

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Friske notes that such an arrangement allows for the securing the mold members together (column 3, line 62 - column 4, line 2).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of Kretzschmar and Doke as such to have used tabs extending from the first section into the second section because these tabs would secure the mold members together as suggested by Friske.

10. Applicant's arguments with respect to claims 1, 15, and 25 have been considered but are moot in view of the new ground(s) of rejection.

11. Claims 4 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest an ophthalmic lens mold comprising a first mold half with a front

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side defining an optical surface and second mold half with a front side defining an optical surface; wherein, upon alignment of the first mold half with respect to the second mold half so that the front sides oppose each other, a mold cavity is formed between the front sides to form an ophthalmic lens therein from a moldable material so that the optical surface form respective opposing optical surfaces of the ophthalmic lens; and wherein the first mold half includes a first section that transmits curing light from a light source and that extends from the back side to the front side, the first section including at least an area of the first mold half optical surface enclosed by an outermost circumference of the ophthalmic lens, and a second section co-molded with the first section and that blocks the curing light, the section disposed with respect to the first section so that the second section prevents the curing light incident to the back side from passing through the first mold half into an area of the mold cavity that extends from the first mold half front side to the second mold half front side and that surrounds and extends radially outward of a boundary including the circumference, and the first section passes incident curing light to an area of the mold cavity bounded by and within the boundary; and wherein the first section includes

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polymethylacrylate and wherein the second section includes polymethylacrylate and butadiene as recited in claims 4 and 18.

The closest prior art disclosed by Kretzschmar is described above. Kretzschmar does not teach or suggest the use of polymethylacrylate for the first and second sections of the mold. The reference of Buazza (U.S. Pat. No. 5,989,462) discussed in previous Office Action does not suggest the use of polymethylacrylate and budadiene in the construction of the filter, nor is the filter part of the mold structure. Therefore, Buazza does not suggest the deficiencies of the Kretzschmar reference.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action,

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and (703) 872-9311 for responses to final actions. The
unofficial fax phone number is (703) 305-3602.



Donald Heckenberg
July 9, 2003



JAMES P. MACKEY
PRIMARY EXAMINER

7/14/03